

REMARKS

Claim Rejections - 35 USC § 103

The Office's conclusion of obviousness is based on hindsight reasoning. Any judgement of obviousness is necessarily a reconstruction based on a hindsight view of the prior art cited. The objection here is that the Office in making its conclusion of obviousness used information gleaned from applicant's disclosure. For example, Kurz cuts and displays cut potatoes as closely packed rectilinear solids in a drawing not to package them but to further process them by coring and then by cooking and filling them to make them stronger and finally packing a totally different part.

10 Fairbank addresses the problem packing fish filets and how to form them into a rectilinear solid. The technology and teachings of Fairbank deal with how to make a flimsy fresh fish filet into a rectilinear package.

Hilton et al. does not anywhere suggest that instead of cut and cooked ribbons of potato dough the technology therein be applied to processing and packing solid uncooked potato chips for later processing. The point is that applicant has discovered that potato processing has heretofore been integrated at one facility, but with processing becoming disintegrated, a way was needed to produce a potato item at one point on the globe and process it elsewhere without significant loss due to breakage.

Hilton et al. solves the finished potato chip breakage problem with an entirely different cooked dough product column stacked after cooking. But for applicant's disclosure the Office would not even recognize the need to package and transport a raw uncooked rectilinear solid potato part for cooking elsewhere without breakage or loss due to fractures. Hence, the reconstruction by the Office is motivated solely by the need first recognized in this application to bulk transport uncooked raw solid cut potato parts.

25 Kurz does not even remotely recognize the need for such a method or product.

The following is an abbreviated excerpt from *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (Fed. Cir. 1985) regarding the application of 35 U.S.C. 103(a) which forms the basis for the obviousness rejections set forth in the Office action:

5 It is error to reconstruct the claimed invention from the prior art by using
 the claim as a "blueprint". When prior art references require selective
 combination to render obvious a subsequent invention, there must be
 some reason for the combination other than the hindsight obtained from
 the invention itself. It is critical to understand the particular results
 10 achieved by the new combination.

The Office has impermissibly deprecated the applicant's invention using hindsight to
 15 pick and choose selected art, using up to four different patents and disparate teachings. *In*
 re Fine, 5 USPQ2d 1788 (Fed. Cir. 1988); *In re Newell*, 13 USPQ2d 1248 (Fed. Cir.
 1989); *In re Gorman* 18 USPQ2d (Fed. Cir. 1991); *In re Fritch*, 23 USPQ2d 1780
 (Fed. Cir. 1992); *In re Zurko* 42 USPQ2d 1476 (Fed. Cir. 1997). The Examiner has
 failed to establish that there is a showing in the prior art of a motivation to package and
 20 ship brick-stacked solid cut potato parts. Unpatentability of applicant's invention by the
 use of permissible hindsight by the Office has not been shown. The Federal Circuit
 requires the Examiner to show a motivation in the art cited to combine the references
 used herein to create the Office's case of obviousness. Clearly here the motive to combine
 was created by the applicant's disclosure. See, *In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir.
 25 1998).

Claims 1-3,7-9 which stand rejected under 35 U.S.C. 103(a) as being
 unpatentable over the combination by the Office of Kurz (US 2027596), Hilton et al.
 (US 4052838), Fairbank (US 2555585), and Birdseye (US 1852228) are amended and re-
 30 presented for re-examination in view of the above-cited case law applicable to the basis
 for the rejection. There is no suggestion, intimation, averment, or motivation expressed or
 appearing in either Kurz, Hilton et al., Fairbank, or Birdseye when each is viewed singly
 to select and combine the features recited in the amended claims. These claims as now

amended are clearly limited to "uncooked potatoes" and/or a method "for eliminating boxing of the cut uncooked potatoes in cartons ...".

The Office has correctly asserted that Kurz teaches (a) "cutting potatoes
 5 into uniform rectilinear shapes" but incorrectly concludes without a full view of the patent that Kurz also teaches (b) "that the cut (potatoes) which are stacked close together and can endure handling and packaging without undue loss" are the same as the applicant's. Detailed examination of the text of Kurz reveals that statement (a) is true but that Kurz actually teaches away from statement (b). According to what is taught by
 10 Kurz the cut potatoes are first bored, then fully cooked *specifically by frying* and then the bore is filled with a viscous filling such as sausage, cheese or the like and therefore must be further processed to endure handling and packaging without undue loss. Nowhere in Kurz is it suggested that the cut potatoes, before being fried and filled, may be "brick-stacked" to produce an uncooked brick-stack of cut potato solid parts as taught by the
 15 applicant. Kurz states at col. 2, lines 6-11 that:

"The finished food product shown in Fig. 1 is so proportioned that the walls of the shell 10 are thin enough to be thoroughly cooked by immersion in hot grease, With these limitations there must also be
 20 considered the strength necessary in the product in order that it may withstand breakage in handling and packing."

Hence, the handling and packing suggested and taught by Kurz refers quite explicitly only to fried or cooked bored and filled cut potatoes and not to the "uncooked" variety now recited in claim 1. More so, it is clear that applicant's method for processing cut
 25 potatoes differs substantially from that of Kurz because it applies only to solid uncooked potato parts, to wit, claim 1 now clearly recites " cutting said uncooked potatoes into rectilinear *solids* of extended length and approximately rectangular cross-section ". Kurz's plastic filled cooked potato member is neither solid nor uncooked. In addition, Kurz is silent in teaching that the packaging minimizes the effects of air and minimizes
 30 the space required as recited in claims 1 and 7, purging the air with an inert gas as recited in claims 2 and 8, or freezing the contents of the package as recited in claims 3 and 9 (See Figures, Column 1, line 40 to Column 2, line 42 Column 3, line 33-40).

Hilton et al. is related to the branded PRINGLESTM formed potato chip product that consists of ground up potato and filler cooked to a crisp. Although Hilton et al. teaches it is known in the art that a benefit of forming uniformly shaped potato product from ground up potatoes is that the products may be packaged in relatively small packages that are more or less air tight, in an inert atmosphere to improve the shelf-life (Column 1, lines 10-55), it does not address, suggest, aver, or intimate the use of its method for an uncooked, solid potato member as now recited in claim 1 and the claims dependant therefrom. It actually teaches away from applicant's invention in that to achieve the utility claimed Hilton et al. must first chop up or grind the potato and make a potato dough and move away from "slices of whole potato" customarily used for conventional potato chips. (Column 1, lines 10-13). Hilton et al. does not teach or suggest a way to package solid uncooked chips. To use teachings of Hilton et al. in this manner the Office would have to impermissibly apply hindsight reconstruction using the blue print provided by the applicant's disclosure for such a suggestion, teaching or motivation is provided neither by Kurz nor Hilton et al.

Fairbank teaches uniformly rectangular food pieces have the advantage that the food can be packaged in a way to minimize the space required and minimize the exposure to air during storage (Column 1, lines 1-41, Column 4, lines 6-17) but further teaches the use of *heat applied to the packaging* after it is filled and contains the foodstuff to accomplish the hermetic sealing. The foodstuff as taught by Fairbank is subjected to this heat. Col. 1, lines 6-10 states,

"In the best practice, the bags are stretched and are unstable to a rise in temperature, so that superficial heating causes the bag to shrink tightly against the foodstuff (fish)."

This fact logically precludes this art being applied to the amended claims limited to solid *uncooked* potatoes formed into pieces of uniform size before being inserted into a package and frozen. Detailed examination of Fairbank reveals that the fish foodstuff is first inserted into the package and the entire package is evacuated and heat sealed using an outer framing pan before it is formed into a uniform brick by freezing. (Col. 4, lines

6-17). Moreover, uncooked means that heat has not been applied. Partially cooked means some heat has been applied.

The Office Action further states that Birdseye also teaches minimizing packaging air space for vegetables to enhance the durability of the packaged vegetables and further teaches freezing for storage (Page 1, lines 1-56, Page 2, lines 25-44). It is unclear to the applicant the purpose of this citation to reject claims 1-3, 7-9 on the ground of obviousness unless to support the suggestion that either the process of Hilton et al. which is limited to a cooked potato dough may in view of Birdseye be applied to fresh vegetables such as applicant's solid uncooked potato members. If so, close inspection of the disclosure in Birdseye reveals the following glaring incongruence: Applicant's novel method eliminates the need for a box to supply the product consisting of multiple solid members in a brick shape. Birdseye achieves the brick shape by using the age-old box, eliminating the top of the box to provide a view and then wrapping the box in a transparent plastic to provide a view and yet protect the variously shaped members of the product therein.

As evinced by the foregoing, for the claims as now limited it is clear that applicant's disclosure must be used as a template or roadmap to direct a modification of the Kurz packaging of cooked replicated potato parts filled with a plastic filling such that it may be used to make obvious claim 1 which is now limited to a method applicable to a like plurality of *solid uncooked potato parts packaged to eliminate a box or carton to achieve a stackable brick structure*. Further limited claims with steps to minimize the effects of air and minimize the space required, are recited in claims 1 and 7, as well as a claim of flushing with an inert gas, as recited in claims 2 and 8.

In view of the limitations now recited in Claim 1, the rejections of Claims 5 and 6 under 35 U.S.C. 103(a) as being unpatentable over Kurz (US 2027596) as applied to claim 1 above, further in view of Hilton et al. (US 4052838), Fairbank (US 2555585), and Birdseye (US 1852228) are obviated in view of the facts disclosed above based on a more detailed analysis of these references and what they actually teach and in view of the

impermissible hindsight reconstruction using applicant's disclosure. Clearly, there is no suggestion, teaching, or motivation presented in Hilton et al. to cut solid replicated uncooked potato chips and package them as taught therein for chips formed from potato dough and then cooked and finally packaged.

5 Claims 5 and 6 have the same limitations as claims 2,3,8, and 9 and are re-presented and allowable over the art cited for the same reasons discussed above.

 Claim 12 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kurz (US 2027596) as applied to claims 10, 11, 13,15,17, and 18 above. Again Kurz as Hilton et al. teaches a method applicable to cooked potato parts. Kurz teaches away from any
10 particular type of potato since rigidity is achieved by cooking and then filling the bored potato part with an amorphous filling which helps to avoid crushing and breakage.

 Claim 10 as amended obviates the rejection of Claim 14 under 35 U.S.C. 103(a) as being unpatentable over Kurz (US 2027596) in view of Lamb (US Re26796) and Marshall et al. (US 3924012). Claims 15 and 16, which recited cooked and partially
15 cooked potato parts have been cancelled.

 Claim 10 and dependent claim 14 now recite: "~~An~~ A stackable brick-shaped arrangement of cut uncooked solid parts of potatoes for food use wherein said cut uncooked solid parts of potatoes are rectilinear solids of extended length ". Lamb teaches a machine which can be used to make the product. There is no averment or suggestion in
20 either Lamb or Marshall et al. of the stackable brick-shaped uncooked solid product recited in the claims re-presented. To support that the product is obvious in view of these references one must impermissibly be motivated and guided by the applicant's disclosure.

 Bradley et al. and Kurz both teach uniform rectangular vegetable pieces, but the raw vegetables are either first cored and then filled and fully cooked in the case of Kurz
25 or partially cooked and frozen, then cut into uniformly rectangular pieces in the case of Bradley et al (Abstract, Figures 4-6, Column 1, lines 5-17, Column 2, lines 30-45,

Column 3, line 1 to Column 4, line 36). The method and product claims re-presented recite an uncooked solid potato part stackable into a brick-like structure, which is packaged without a box or carton. This brick-like packaged product is then used to create another container comprised of the brick-stackable packages. No motivation other than
5 applicant's disclosure is provided for combining the art presented. Hence, the rejection of the amended claims is supported only by hindsight reconstruction using prior art that teaches incongruently away from the novel brick-stack invention.

Claims 16 and 17 are cancelled. Claims 15, 19, 20, and 21 are withdrawn without prejudice.

10 The prior art made of record is pertinent to applicant's disclosure. Rosenberger (US 6210733 B1), Whitehouse et al. (US 6521280 B1), Smith et al. (US 3654745), and Croft (US 6074677) have been reviewed and carefully examined. None of these references whether taken singly or combined with the references relied upon suggest, aver, or intimate the novel method which eliminates the need for packaging cartons or the
15 novel stackable brick-like uncooked solid potato structure produced by the method.

No new matter is added by these amendments. Sincere thanks is hereby expressed to the Examiner for a thorough and diligent search and recitation of all of the prior art; and, for the detailed and comprehensive examination of the claims. This has enabled a narrowing of scope sufficient to now accurately capture the novelty of the
20 invention.

Patentable subject matter is presented by this disclosure. In the event that the Office finds the claims to the subject still to be too broad, applicant requests the application of policy of the Office whereby when patentable subject matter is presented that the Office draft and suggest an allowable claim and contact applicant's attorney to
25 consider same via a telephone interview.

This invention is *subtle* and yet unobvious-- Imagine uncooked PringlesTM, not

pieces of dough, but actual solid chips neatly stacked with minimal air in-between, sealed in a clear bag for sale to be cooked later. Step back and now imagine the chips as miniature 4x4s of uncured untreated potato. This is the invention. It is an invention not even remotely intimated by the art cited. For the record, applicant owns and operates a significant food process facility in the United States and has successfully adapted the invention for use in his business.

Acceptance and entry of the amendment is solicited. Prompt re-examination on the merits is requested. It is believed that the application is now in a condition for allowance of the remaining amended claims. A Notice of Allowance is solicited.

Should corrections be required or unintentional omissions giving rise to less than a plenary response be found, it is requested that the Examiner contact the undersigned at (609) 882-2111 in an effort to obtain a speedy resolution by a telephone interview and Examiner's amendment.

Respectfully submitted,
William Lawrence Muckelroy PC

Bill Muckelroy, Esq
Reg. No. 26,961

Dated: August 14, 2003
Phone 1-609-882-2111/ Fax 1-609-883-3322
Enclosures: Certificate of Mailing
Cc: Client

CERTIFICATE OF MAILING

I hereby certify that on August 15, 2003 this Amendment A is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Typed or printed name of person signing this certificate: Irene Christine

Signature: Irene Christine
Irene Christine